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Sandra L. Kogan

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EXAMINER

JARRETT, SCOTT L

ART UNIT

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/735,087	Applicant(s) KOGAN ET AL.	
	Examiner SCOTT L. JARRETT	Art Unit 3624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 April 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

37 CFR § 1.105 - Requirement for Information

Applicant and the assignee of this application are required under 37 CFR 1.105 to provide the following information that the examiner has determined is reasonably necessary to the examination of this application.

The information is required to identify products and services embodying the disclosed subject matter of tracking the status of a workflow and/or utilizing weblogs for project/workflow management/tracking and identify the properties of similar products and services found in the prior art.

In response to this requirement, please provide the citation and a copy of each publication which any of the applicants authored or co-authored and which describe the disclosed subject matter of tracking the status of a workflow and/or utilizing weblogs for project/workflow management/tracking.

In response to this requirement, please provide the citation and copy of each publication that is a source used for the description of the prior art in the disclosure. For each publication, please provide a concise explanation of that publication's contribution to the description of the prior art.

In response to this requirement, please provide the citation and a copy of each publication that any of the applicants relied upon to develop the disclosed subject matter that describes the applicant's invention, particularly as to

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developing a method/system for tracking the status of a workflow and/or utilizing weblogs for project/workflow management/tracking. For each publication, please provide a concise explanation of the reliance placed on that publication in the development of the disclosed subject matter.

In response to this requirement, please provide the citation and a copy of each publication that any of the applicants relied upon to draft the claimed subject matter. For each publication, please provide a concise explanation of the reliance placed on that publication in distinguishing the claimed subject matter from the prior art.

In response to this requirement, please provide the names of any products or services that have incorporated the claimed subject matter.

In response to this requirement, please state the specific improvements of the claimed subject matter in claims over the disclosed prior art and indicate the specific elements in the claimed subject matter that provide those improvements. For those claims expressed as means or steps plus function, please provide the specific page and line numbers within the disclosure which describe the claimed structure and acts.

The applicant is reminded that the reply to this requirement must be made with candor and good faith under 37 CFR 1.56. Where the applicant does not

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have or cannot readily obtain an item of required information, a statement that the item is unknown or cannot be readily obtained will be accepted as a complete response to the requirement for that item.

In responding to those requirements that require copies of documents, where the document is a bound text or a single article over 50 pages, the requirement may be met by providing copies of those pages that provide the particular subject matter indicated in the requirement, or where such subject matter is not indicated, the subject matter found in applicant's disclosure.

The fee and certification requirements of 37 C.F.R. § 1.97 are waived for those documents submitted in reply to this requirement. This waiver extends only to those documents within the scope of this requirement under 37 C.F.R. § 1.105 that are included in the applicant's first complete communication responding to this requirement. Any supplemental replies subsequent to the first communication responding to this requirement and any information disclosures beyond the scope of this requirement under 37 C.F.R. § 1.105 are subject to the fee and certification requirements of 37 C.F.R. § 1.97.

This requirement is an attachment of the enclosed Office action. A complete response to the enclosed Office action must include a complete response to this requirement. The time period for reply to this requirement

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coincides with the time period for reply to the enclosed Office action, which is 3 months.

DETAILED ACTION

1. This Non-Final Office Action is in response to Applicant's request for continued examination filed April 27, 2009. Applicant's amendment amended independent claims 1, 10 13, 18, and 23. Currently claims 1-29 are pending.

Continued Examination Under 37 CFR 1.114

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on April 27, 2009 has been entered.

Response to Amendment

3. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action.

Response to Arguments

4. Applicant's arguments with respect to claims 1-29 have been considered but are moot in view of the new ground(s) of rejection.

In response to Applicant's arguments filed April 27, 2009 that the prior art fails to teach or suggest each and every element of the claimed invention,

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specifically that the prior art fails to teach or suggest automatically post an entry in the weblog to indicate that a workflow action has occurred, the examiner respectfully disagrees.

MS Project teaches a system and method for tracking the status of a workflow comprising posting an entry in the weblog to indicate that a workflow action has occurred (TeamUpdate, Team Status Update, Timesheet; Paragraph 1, Page 118; Steps 1-4, Page 31; Figures 15.17-15.19; 15.28-15.29, 15.36).

Clark teaches a system and method for tracking the status of a workflow comprising automatically determining, updating and posting (notifying, logging, recording, etc.) when workflow action status change - specifically automatically logging when a workflow action is completed (Column 13, Lines 5-43; Figure 11, Elements 400, 410) in an analogous art of workflow status/progress tracking for the purpose of obtaining real-time and/or accurate workflow action status (Column 1, Lines 60-68; Column 13, Lines 30-36).

Accordingly it would have been obvious to one skilled in the art at the time of the invention that the system and method for tracking status of a workflow as taught by MS Project would have benefited from automatically posting an entry in the project to indicate that a workflow action has occurred in view of the teachings of Clark; the resultant system and method enabling users to automatically obtain real-time project status (Clark: Column 1, Lines 60-68).

Further since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed

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the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

Additionally it is noted that it was known at the time of the invention that merely providing an automatic means to replace a manual activity which accomplishes the same result is not sufficient to distinguish over the prior art, *In re Venner*, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958). For example, simply automating the step of posting an entry in the weblog to indicate that a workflow action has occurred gives you just what you would expect from the manual step as shown in MS Project. In other words there is no enhancement found in the claimed step. The claimed scoring step only provides automating the manual activity. The end result is the same as compared to the manual method. A computer can simply iterate the steps faster. The result is the same.

Accordingly it would have been obvious to a person of ordinary skill in the art at the time of the invention to automate the posting an entry in the weblog to indicate that a workflow action has occurred step because this would speed up the process of matching policies with customers, which is purely known, and an expected result from automation of what is known in the art.

It is noted that the officially cited facts in the previous office action as presented are herein after prior art. Specifically it has been established that it was old and well known in the art at the time of the invention to utilize weblog (blogs, bulletin boards, message boards, etc.) when managing projects as more

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specifically to provide a feed to an aggregator, the aggregator receiving entries from a weblog wherein the feed comprises provided an RSS feed from a plurality of weblogs for syndication is old and very well known wherein such aggregators/RSS feeds provide a simple way to keep users informed of changes in a plurality of web sites, blogs, weblogs or other online content.

Claim Rejections - 35 USC § 101

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claims 1-9, 18-22 and 23-29 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Regarding Claims 1-9, as recited, claims 5-6 are directed toward a computer program, software per se (e.g. Application). However, under the current guidelines of 35 USC 101, computer software must be tangibly embodied on a computer readable medium, and, when executed by a computer processor, perform the steps of the software. In their broadest reasonable interpretation and in light of the specification, claims 1-9, as recited, can be interpreted to be embodied on abstract mediums such as carrier waves and signals, and therefore not eligible for patent protection. Accordingly, claims 1-9 are not eligible for patent protection.

Based on Supreme Court precedent, a method/process claim must (1) be tied to another statutory class of invention (such as a particular apparatus) (see at least *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876)) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing (see at least *Gottschalk v. Benson*, 409 U.S. 63, 71 (1972)).

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A method/process claim that fails to meet one of the above requirements is not in compliance with the statutory requirements of 35 U.S.C. 101 for patent eligible subject matter. Here claim 7 fail to meet the above requirements because they are not tied to another statutory class of invention.

Nominal recitations of structure in an otherwise ineligible method fail to make the method a statutory process. See *Benson*, 409 U.S. at 71-72. As *Comiskey* recognized, "the mere use of the machine to collect data necessary for application of the mental process may not make the claim patentable subject matter." *Comiskey*, 499 F.3d at 1380 (citing *In re Grams*, 888 F.2d 835, 839-40 (Fed. Cir.1989)). Incidental physical limitations, such as data gathering, field of use limitations, and post-solution activity are not enough to convert an abstract idea into a statutory process. In other words, nominal or token recitations of structure in a method claim do not convert an otherwise ineligible claim into an eligible one.

Regarding Claims 18-22, claims 18-22 do not utilize the proper computer program product format and effectively recite descriptive material (software) per se and are therefore deemed to be directed to non-statutory subject matter where there is no indication that the proposed software is recorded on computer-readable medium and/or capable of execution by a computer.

Examiner suggests that the applicant incorporate into Claims 18-22 language that the proposed software is recorded on computer-readable medium and capable of execution by a computer to overcome this rejection.

Correction required. See MPEP § 2106 [R-2].

Regarding Claims 23-29 are directed to a computer data signal embedded in a carrier wave which is an abstract medium and therefore not eligible for patent protection. Accordingly, claims 1-9 are not eligible for patent protection.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-4, 7-11, 13-14, 16-19, 21-26 and 28-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Microsoft Project 2000 as evidenced by at least Pyron et al., Using Microsoft Project 2000 (2000; MS Project) in view of Clark, U.S. Patent No. 7,062,449.

Regarding Claims 1, 10, 13 18 and 23 MS Project teaches a system and method for tracking the status of a workflow (project) comprising:

- generating a weblog (log, journal, diary, web page/site, posting, discussion board, bulletin board, threaded discussion, etc.) to track an instance of the workflow (project; e.g. Project Central Home Page, messages, posted actions, tasks, etc.; Bullets 1, 3-5, Page 22; Figures 15.3, 15.4, 15.5), the weblog being an application (system, code, subsystem, computer, object, device, etc.) separate from the workflow (i.e. the message posted are not part of the workflow itself, they are part of the MS Project system tracking the workflow which occurs outside of the application, i.e. in the real world with human resources performing the workflow steps/actions; Bullets 1, 3-5, Page 22; Figures 15.3, 15.4, 15.5), the workflow having a plurality of workflow steps, each step performed by at least

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one member (Personal Gantt, Figures 15.3, 15.45), each of the members having at least one workflow role (e.g. project manager vs. team member, etc.; Figures 15.5 – project members posting project tasks/workflow step status);

- assigning the at least one member to the weblog (e.g. personal home/project page, workgroups; TeamAssign; Steps 1-6, Pages 108-109; Figures 15.6, 15.8-15.9, 15.45); and

- posting an entry in the weblog to indicate that a workflow action (project task) has occurred (TeamUpdate, Team Status Update, Timesheet; Paragraph 1, Page 118; Steps 1-4, Page 31; Figures 15.17-15.19; 15.28-15.29, 15.36).

- a display screen, input device and server (website – project central server – browser; Figures 15.,3, 15.10).

Figure 15.3. The Project Central home page provides an overview of messages, tasks, and status

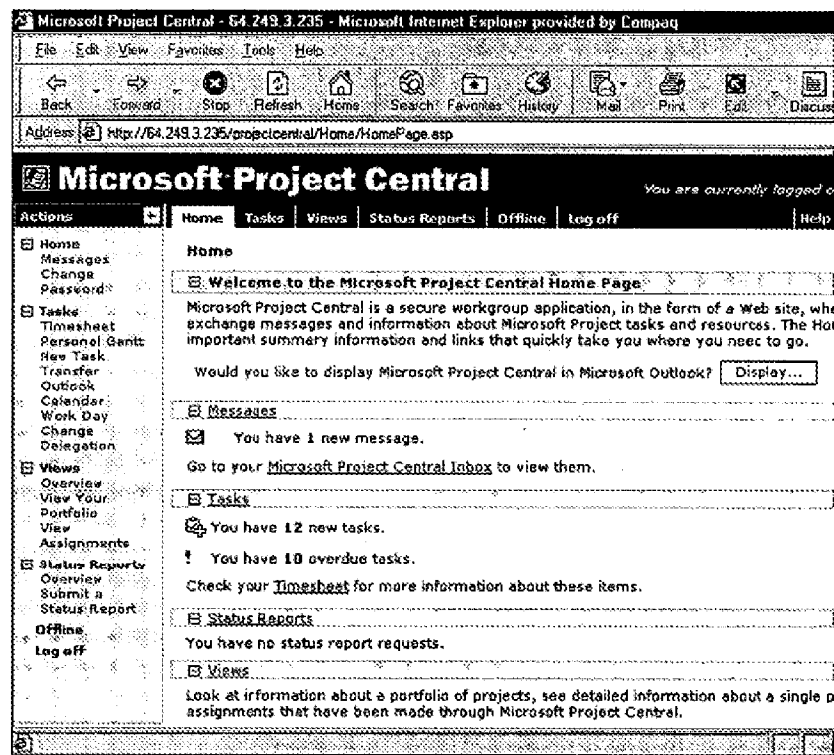
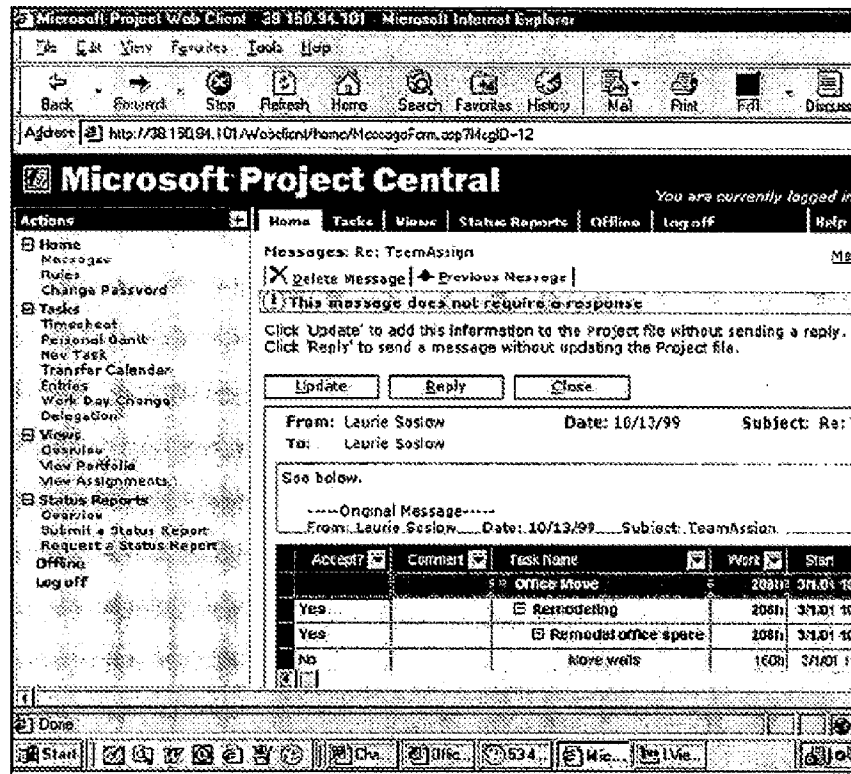


Figure 15.13. The project manager receives this message when a task assignment is declined via Project C



MS Project does not expressly teach automatically updating the status of a workflow action when the action has occurred as claimed.

Clark teaches a system and method for tracking the status of a workflow comprising automatically determining, updating and posting (notifying, logging, recording, etc.) when workflow action status change - specifically automatically logging when a workflow action is completed (Column 13, Lines 5-43; Figure 11, Elements 400, 410) in an analogous art of workflow status/progress tracking for the purpose of obtaining real-time and/or accurate workflow action status (Column 1, Lines 60-68; Column 13, Lines 30-36).

It would have been obvious to one skilled in the art at the time of the invention that the system and method for tracking status of a workflow as taught by MS Project would have benefited from automatically posting an entry in the project to indicate that a workflow action has occurred in view of the teachings of Clark; the resultant system and method enabling users to automatically obtain real-time project status (Clark: Column 1, Lines 60-68).

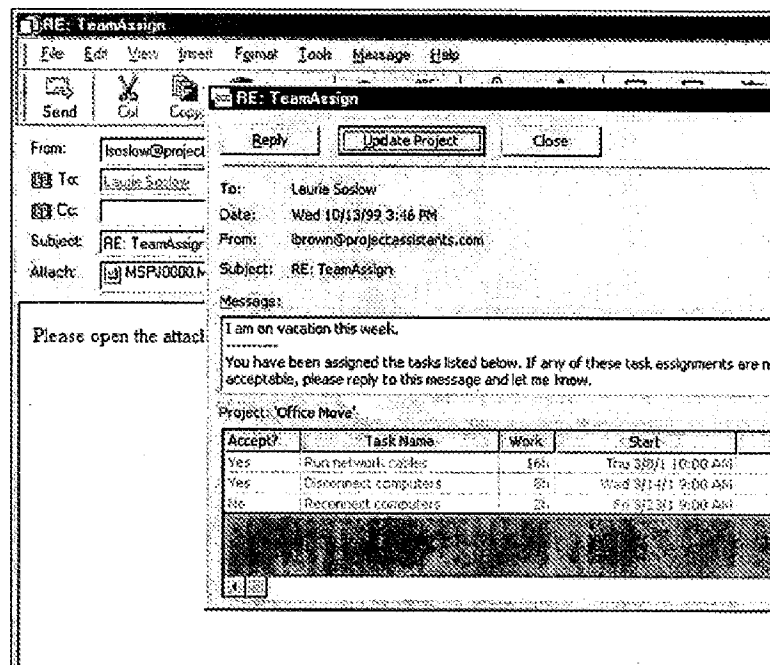
Further since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

Additionally it is noted that it was known at the time of the invention that merely providing an automatic means to replace a manual activity which accomplishes the same result is not sufficient to distinguish over the prior art, *In re Venner*, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958). For example, simply automating the step of posting an entry in the weblog to indicate that a workflow action has occurred gives you just what you would expect from the manual step as shown in MS Project. In other words there is no enhancement found in the claimed step. The claimed scoring step only provides automating the manual activity. The end result is the same as compared to the manual method. A computer can simply iterate the steps faster. The result is the same.

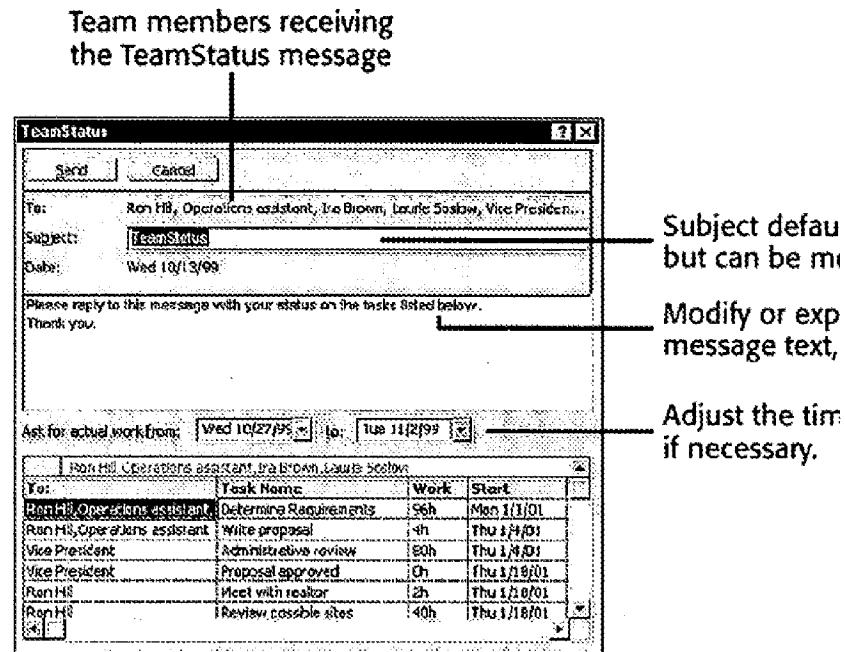
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Accordingly it would have been obvious to a person of ordinary skill in the art at the time of the invention to automate the posting an entry in the weblog to indicate that a workflow action has occurred step because this would speed up the process of matching policies with customers, which is purely known, and an expected result from automation of what is known in the art.

Regarding Claims 2, 14 and 24 MS Project teaches a system and method for tracking the status of a workflow wherein the workflow action comprises the completion of a workflow step (project task, Team Status; Steps 1-4, Pages 25-26; Pages 117, 122; Figure 15.15-15.17; Figure 15.36 – responding to a status report).



Updating the Project Plan with TeamAssign Replies



Regarding Claims 3 and 25 MS Project teaches a system and method for tracking the status of a workflow wherein the workflow action comprises the execution of a workflow exception (status report: hot issues, change requests; late tasks, etc.; Figures 15.21, 15.34, 15.39).

Figure 15.21. This icon displays the tracking status of the task.

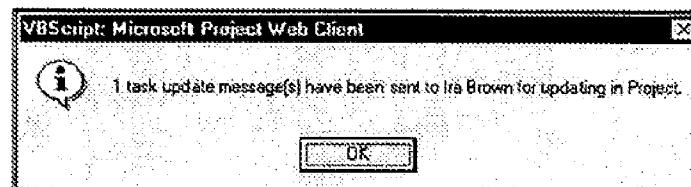
	Phase One	Widget One	32h
	Design	Widget One	8h
	A status update for this task has been sent to Ira Brown but has not yet been updated in the project.		
	This task was scheduled to finish on 10/6/99 5:00 PM but it has not yet been completed		
		Widget One	8h
		Widget One	8h
		Widget One	8h

Regarding Claims 4 and 19 MS Project teaches a system and method for tracking the status of a workflow further comprising posting an entry in a personal

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weblog (journal, diary, web page/site/form, discussion board, bulletin board, etc.) to indicate that the workflow action (project task) has occurred (TeamUpdate, Team Status Update, Timesheet – all update project and task status on the project central web site; Steps 1-4, Page 31; Figures 15.17-15.19; 15.28-15.29, 15.36).

Figure 15.28. This message alerts you that the update has been successfully sent to the proje



Regarding Claims 7, 11, 16, 21, 26 and 28 MS Project teaches a system and method for tracking the status of a workflow wherein the posting of an entry in the workflow weblog (project central web site) is made in response to a posting of an entry in a personal weblog (e.g. project team members updated their personal Gantt chart and/or project tasks via their personal project home page which in turn updates the entire project website/log; TeamStatus; Steps 1-4, Pages 25-26; Pages 117, 122; Figure 15.15-15.17; Figure 15.36 – responding to a status report).

Regarding Claims 8-9, 17, 22 and 29 MS Project teaches a method and system for tracking the status of a workflow further comprising limiting viewing of the contents of the weblog to a plurality of predetermined users wherein the

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predetermined users comprise at least one of the at least one members assigned to the weblog (access control, login, etc.; Figure on Page 20).

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9. Claims 5-6, 12, 15, 20 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Microsoft Project 2000 as evidenced by at least Pyron et al., Using Microsoft Project 2000 (2000; MS Project) in view of Clark, U.S. Patent No. 7,062,449 as applied to claims 1-4, 7-11, 13-14, 16-19, 21-26 and 28-29 above, and further in view of Official Notice.

Regarding Claims 5-6, 12, 15, 20 and 27 MS Project teaches a system and method for tracking the status of a workflow further comprising aggregating the received entries into a weblog (Microsoft Project Central Home Page, Project Plan, etc.) as discussed above.

MS Project does not expressly teach providing a feed to an aggregator wherein the feed comprises an RSS feed from a plurality of weblogs for syndication.

Official notice is taken that providing a feed to an aggregator, the aggregator receiving entries from a weblog wherein the feed comprises provided an RSS feed from a plurality of weblogs for syndication is old and very well known wherein such aggregators/RSS feeds provide a simple way to keep users informed of changes in a plurality of web sites, blogs, weblogs or other online content.

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Support for this officially cited fact can be found in at least the following references:

- White, CMS Implementation-project management (2002; “There is reasonable justification with a project of this scope to use some form of collaborative platform and I have seen a Weblog used quite effectively to keep everyone on a project team informed and involved.”; Last Paragraph, Page 3);
- Gillmor, RSS Starting to catch on (2003; Column 2, Paragraphs 1-2; Column 3, Last Two Paragraphs, Page 19); and
- Arnold, Social Software (2003; Column 1, Last Paragraph; Column 2, Paragraph 1, Page 30).

It would have been obvious to one skilled in the art at the time of the invention that the online (web) system and method for tracking the status of a workflow as taught by MS Project would have benefited from utilizing web feeds/syndication (e.g. RSS) to provide team members with a summary of changes to the MS Project Central web site/pages (weblog) thereby enabling them to keep current on the projects status/progress and/or other new project-related information.

Conclusion

This Office action has an attached requirement for information under 37 C.F.R. § 1.105. A complete response to this Office action must include a complete response to the attached requirement for information. The time period for reply to the attached requirement coincides with the time period for reply to this Office action.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Nemoto et al., U.S. Patent No. 6,651,033, teaches a system and method for automatically tracking the status of a workflow.

- Udell, Internet Groupware for Scientific Collaboration (2000), teaches the well known utilization of common Internet applications/technologies to collaborate on projects/workflows including but not limited to the use of weblogs and RSS.

- Udell, Telling a Story: The weblog as a project management tool (2001), teaches a system and method for tracking the status of a project/workflow using a weblog wherein an entry is posted in the weblog to indicate the status of the project/that a workflow action has occurred.

- Udell, Publishing a project Weblog (2003), teaches a system and method for tracking the status of a workflow comprising generating a weblog to track an instance of a workflow/project wherein the weblog is an application separate from the workflow.

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- McGee, Weblogs and knowledge management part 2 (2003), teaches the use of project weblogs to track and communicate the status of projects.

- Mike Diehl's WebLog – Blogging For Project Management (2003), teaches the utilization of weblogs, as a separate application, to track the status/progress of a project/workflow.

- Callaghan, IBM Previews Blogging Tool (2005), teaches a commercially available (approx. in 2002/2003) workplace blogging tool ("IBM already offers blogging capabilities within its flagship **Domino collaboration product**. Richard Schwartz, principal of RHS Consulting Inc., **has used the Domino tool to publish his own blog for the *last two-and-a-half years***, one of more than 100 publicly accessible blogs built on Domino. Schwartz said the *Workplace blogging tool announcement was about more than gaining feature parity with Domino.*", emphasis added).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SCOTT L. JARRETT whose telephone number is (571)272-7033. The examiner can normally be reached on Monday-Friday, 8:00AM - 5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bradley Bayat can be reached on (571) 272-6704. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Scott L Jarrett/
Primary Examiner, Art Unit 3624